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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/743,466

12/23/2003

Takeshi Ootsuka

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EXAMINER

TURCHEN, JAMES R

ART UNIT

PAPER NUMBER

2112

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
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3 MONTHS

01/04/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 01/04/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	Application No. 10/743,466	Applicant(s) OOTSUKA ET AL.	
	Examiner James Turchen	Art Unit 2112	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :3/23/2004 & 6/15/2004 & 08/09/2006.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 6, 7, 9, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guedalia et al. (US 6,148,333) in view of Fuji Xerox Co Ltd (JP 2002-342060).

Regarding claims 1-3, 16 and 17:

Guedalia et al. discloses having an image database (column 9 line 62) which stores original data and having a second memory (column 10 lines 23-29) within the server that will implement the watermark. Guedalia et al. also discloses when a user at a terminal requests a file, the server adds a watermark based upon the user's username and privilege and the file's policy and transmits the file (column 10 lines 23-67 to column 11 lines 1-13). Guedalia et al. does not disclose original data to image data transformation. Fuji Xerox Co Ltd discloses transforming original data to image data and applying a watermark to image data (paragraph 27). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the image server of Guedalia et al. with the original data to image data conversion of Fuji Xerox Co Ltd in order to allow a user to print the data.

Regarding claim 4:

Guedalia et al. discloses associating a watermark with a username and it's permissions to a document (column 10 lines 23-67 to column 11 lines 1-48). A document and a watermark is dependent upon the company that publishes them and the level of restriction given.

Regarding claims 6 and 7:

Guedalia et al. discloses allowing a user access to the original file if the user has permission to view the original file (column 11 lines 35-57). Obtaining the original file would allow a user to print the original data. Guedalia does not disclose sending the data to a printer. Fuji Xerox Co Ltd disclose sending the image file to a printer to be printed (paragraph 27). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the image server with user permission levels with the printing system disclosed in Fuji Xerox Co Ltd in order to send the data to a printer.

Regarding claim 9:

Guedalia et al. discloses a server. A server places recently used items into cache for the possibility that the item will be recalled or called by a different client.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guedalia et al. and Fuji Xerox Co Ltd as applied to claim 3 above, and further in view of Stefik et al. (2001/0008557).

Guedalia et al. and Fuji Xerox Co Ltd disclose all of the limitations of claim 1, but they do not disclose the user ID within the watermark. Stefik et al. discloses having the username in the watermark (Figure 6, 616-617). It would have been obvious to one of ordinary skill in the art to combine the system disclosed in claim 1 with the system that includes the username in the watermark of Stefik et al. in order to specify the "fingerprint" information associated with the printing of the digital work (paragraph 102).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guedalia et al. and Fuji Xerox Co Ltd as applied to claim 7 above, and further in view of Nakao et al. (2001/0054152).

Guedalia et al. and Fuji Xerox Co Ltd disclose all of the limitations of claim 7, but they do not disclose a print log. Nakao et al. discloses a print log and recording information that was printed into the print log (paragraph 183). It would have been an obvious improvement to further include the file that was printed and by whom it was printed. It would have been obvious to one of ordinary skill in the art to combine the system disclosed in claim 7 with the print log of Nakao et al. in order to keep track of printer usage (paragraph 183).

Claims 10, 11, 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guedalia et al. (US 6,148,333) in view of Stefik et al. (2001/0008557) and Fuji Xerox Co Ltd (JP 2002-342060).

Guedalia et al. discloses having an image database (column 9 line 62), which stores original data and having a second memory (column 10 lines 23-29) within the server that will implement the watermark. Guedalia et al. also discloses when a user at a terminal requests a file, the server adds a watermark based upon the user's username and privilege and the file's policy (column 10 lines 23-67 to column 11 lines 1-13). Guedalia et al. additionally discloses having a privileged user and a non-privileged user group (column 11 lines 12-48). Guedalia et al. does not disclose original data to image data transformation. Fuji Xerox Co Ltd discloses transforming original data to image data and applying a watermark to image data (paragraph 27). Guedalia et al. also does not disclose a watermark related to user ID and document ID. Stefik et al. discloses having the username in the watermark of a specific document along with other various information such as document name and place of printing (Figure 6, 616-617). It is

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inherent that one should pick the watermark that relates to the user ID and document ID of the user using the file regardless of other user IDs. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the image server of Guedalia et al. with the original data to image data conversion system of Fuji Xerox Co Ltd and the system of Stefik et al. that includes the username in the in order to specify the "fingerprint" information associated with the printing of the digital work (Stefik et al. paragraph 102) and to allow a user to print the data.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guedalia et al. (US 6,148,333) in view of Stefik et al. (2001/0008557) and Fuji Xerox Co Ltd (JP 2002-342060).

Guedalia et al. discloses having an image database (column 9 line 62), which stores original data and having a second memory (column 10 lines 23-29) within the server that will implement the watermark. Guedalia et al. also discloses when a user at a terminal requests a file, the server adds a watermark based upon the user's username and privilege and the file's policy which is dependent upon which folder the file is in (column 10 lines 23-67 to column 11 lines 1-13). Guedalia et al. additionally discloses having a privileged user and a non-privileged user group (column 11 lines 12-48). Guedalia et al. does not disclose original data to image data transformation. Fuji Xerox Co Ltd discloses transforming original data to image data and applying a watermark to image data (paragraph 27). Guedalia et al. also does not disclose a watermark related to user ID and document ID. Stefik et al. discloses having the username in the watermark of a specific document along with other various information such as



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document name and place of printing (Figure 6, 616-617). One would necessarily pick the watermark that relates to the user ID and document ID instead of the watermark that relates more broadly to all data within a file. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the image server of Guedalia et al. with the original data to image data conversion system of Fuji Xerox Co Ltd and the system of Stefik et al. that includes the username in the in order to specify the "fingerprint" information associated with the printing of the digital work (Stefik et al. paragraph 102) and to allow a user to print the data.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guedalia et al (US 6,148,33) in view of Stefik et al. (2001/0008557).

Guedalia et al. discloses a terminal apparatus configured to receive the document data with the watermark or without the watermark from the server (column 11 lines 12-57) and inputting the user ID and document ID and requesting the document based on those two inputs and receiving a document (column 13 lines 2-15). Guedalia et al. does not disclose the use of printers. Stefik et al. discloses printing to a internet printer (paragraph 70) or printing from a personal computer to a personal printer (paragraphs 112-123). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the watermarking system of Guedalia et al. with the printing system of Stefik et al in order to print the documents.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references cited disclose watermarking and file serving or combinations of the two.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Turchen whose telephone number is 571-270-1378. The examiner can normally be reached on MTWRF 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walt Griffin can be reached on 571-272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JRT

  
WALTER D. GRIFFIN  
SUPERVISORY PATENT EXAMINER